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GARLICK & MARKISON
P.O. BOX 160727
AUSTIN, TX 78716-0727

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RYAN, PATRICK A	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEYHAN KARAOGUZ and JAMES BENNETT

Appeal 2009-015046
Application 10/675,057
Technology Center 2400

Before GREGORY J. GONSALVES, KALYAN K. DESHPANDE, and DAVID M. KOHUT, *Administrative Patent Judges*.

DESHPANDE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE[1]

The Appellants seek review under 35 U.S.C. § 134(a) of a final rejection of claims 1-40, the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

We AFFIRM-IN-PART and ENTER A NEW GROUND OF REJECTION PURSUANT TO 37 C.F.R §41.50(b).

The Appellants invented a method and system for mixing broadcast and stored media in a media exchange network. Specification ¶ 04.

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added]:

> 1. A method for customizing a channel, the method comprising:
> [1] creating a channel guide for a new channel that supports communication of media, said new channel comprising a media channel;
> [2] populating, at a first location, said channel guide for said new media channel with information identifying mixed media content, wherein said populated channel guide may be pushed to a second location; and
> [3] one or both of:
> [a] displaying said information identifying said mixed media content within said channel guide; and/or
> [b] communicating said mixed media content via said new media channel.

[1] Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed Apr. 15, 2009) and Reply Brief ("Reply Br.," filed Aug. 10, 2009), and the Examiner's Answer ("Ans.," mailed June 8, 2009), and Final Rejection ("Final Rej.," mailed June 11, 2008).

REFERENCES

The Examiner relies on the following prior art:

Ellis	US 6,774,926 B1	Aug. 10, 2004
Novak	US 7,103,905 B2	Sep. 5, 2006
Wood	US 2002/0054752 A1	May 9, 2002

REJECTIONS

Claims 34, 37, and 40 stand rejected under 35 U.S.C §112, first paragraph, as failing to comply with the written description requirement.

Claims 1-33, 35, 36, 38, and 39 stand rejected under 35 U.S.C §103(a) as being unpatentable over Wood and Novak.

Claims 34, 37, and 40 stand rejected under 35 U.S.C §103(a) as being unpatentable over Wood, Novak, and Ellis.

ISSUES

The issue of whether the Examiner erred in rejecting claims 34, 37, and 40 under 35 U.S.C §112, first paragraph, as failing to comply with the written description requirement turns on whether the Specification conveys to a person with ordinary skill in the art that the Appellants were in possession of the claimed invention and specifically the feature of "pushing at least a portion of said populated channel to said second location in exchange for at least a portion of a second populated channel guide associated with a second media channel created at said second location," as required by claims 34, 37, and 40.

The issue of whether the Examiner erred in rejecting claims 1-33, 35, 36, 38, and 39 under 35 U.S.C §103(a) as being unpatentable over Wood and Novak turns on whether the combination of Wood and Novak teach or

suggest a single channel guide that includes mixed media content, where the mixed media content includes both broadcast and personal media content.

The issue of whether the Examiner erred in rejecting claims 34, 37, and 40 under 35 U.S.C §103(a) as being unpatentable over Wood, Novak, and Ellis turns on whether the combination of Wood, Novak, and Ellis teach or suggest "pushing at least a portion of said populated channel to said second location in exchange for at least a portion of a second populated channel guide associated with a second media channel created at said second location," as required by claims 34, 37, and 40.

ANALYSIS

Claims 34, 37, and 40 rejected under 35 U.S.C §112, first paragraph, as failing to comply with the written description requirement

The Examiner found that the limitation "pushing at least a portion of said populated channel to said second location in exchange for at least a portion of a second populated channel guide associated with a second media channel created at said second location" is not supported by the Specification. Ans. 3-4. The Examiner specifically found that the Specification is unclear as to the reciprocal relationship between the pushed media in exchange for having received a created media channel. Ans. 4. The Appellants contend that the Specification is replete with the term "exchange" and the Specification specifically supports the disputed limitation on 9:1-25, 11:12-20, 18:4-25, and 20:12-18. App. Br. 8 and Reply Br. 2.

We disagree with the Appellants. To satisfy the written description requirement the disclosure of the prior application must "convey with

reasonable clarity to those skilled in the art that, as of the filing date sought, [the inventor] was in possession of the invention." *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). While the Specification is, in fact, replete with the term "exchange," the Specification does not describe this feature with reasonable clarity to convey that the Appellants were in possession of this feature. The Appellants point to several portions of the Specification for support, but fail to specifically identify how these portions describe the "in exchange" feature with reasonable clarity. Absent clear evidence or persuasive rationale that the Specification supports this feature, we find that claims 34, 37, and 40 fail to satisfy the written description requirement.

Claims 1-33, 35, 36, 38, and 39 rejected under 35 U.S.C §103(a) as being unpatentable over Wood and Novak

The Appellants first contend that the combination of Wood and Novak fails to teach or suggest "populating, at a first location, said channel guide for said new media channel with information identifying mixed media content, wherein said populated channel guide may be pushed to a second location," as recited by claims 1, 11, and 21. App. Br. 9-11 and Reply Br. 2-4. The Appellants specifically argue that the combination of Wood and Novak fails to teach or suggest a single channel that includes both broadcast and personal media content. App. Br. 9-11 and Reply Br. 2-4.

We disagree with the Appellants. Claim 1 requires, *inter alias*, populating the channel guide with information identifying mixed media content. Claims 11 and 21 recite similar limitations. While the Specification discloses that the term "mixed media content" includes

personal and broadcast media (Specification ¶ 32), the Specification provides these mixed media as an example and does not limit the claims to such a definition. The Examiner found that "mixed media content" encompasses media of different formats or types, such as picture files, audio files, and video files. Ans. 14. We find that this construction of the term "mixed media content" is both reasonable and consistent with the Specification. As also found by the Examiner, Novak teaches a channel guide that contains different file types, including video clip file types, JPEGs, MPEGs. Ans. 14 and Novak Fig. 7 and 11:1-28. Since Novak teaches different file types, we find that the combination of Wood and Novak teaches populating the channel guide with information identifying mixed media content.

Claims 23-25, 31-33, 35, 36, 38, and 39 depend from independent claims 1, 11, and 21 and the Appellants do not present separate arguments in support of these claims. As such, we sustain the Examiner's rejection of these claims for the same reasons.

The Appellants further contend that the combination of Wood and Novak fails to teach or suggest "the mixed media content comprises at least one personal media content and at least one broadcast media content," as required by claims 2, 12, and 22. App. Br. 12 and Reply Br. 5. Here we agree with the Appellants. Claims 2, 12, and 22 are distinguished from claims 1, 11, and 21 in that the scope of the term "mixed media content" is limited to both broadcast media content and personal media content. While we find that the combination of Wood and Novak teaches mixed media content, we find no evidence on the record that the cited prior art describes a channel guide that includes both broadcast and personal media content. The

Examiner argues that the combination of Wood's teaching of broadcast media content and Novak's teaching of personal media content renders these claims obvious. Ans. 17. However, we agree with the Appellants that the claims require a channel guide that includes both broadcast and personal media content and therefore the Examiner's findings of a channel guide including only one of broadcast or personal media content fails to render the claims obvious.

As such, we do not sustain the Examiner's rejection of claims 2, 12, and 22. Claims 3-10, 13-20, and 26-29 depend from claims 2, 12, and 22 and therefore we do not sustain the rejection of these claims for the same reasons.

Claims 34, 37, and 40 rejected under 35 U.S.C §103(a) as being unpatentable over Wood, Novak, and Ellis

The Appellants contend that the combination of Wood, Novak, and Ellis fail to teach or suggest "pushing at least a portion of said populated channel to said second location in exchange for at least a portion of a second populated channel guide associated with a second media channel created at said second location," as required by claims 34, 37, and 40. App. Br. 12-13 and Reply Br. 5.

We agree with the Appellants. The Examiner found that Ellis teaches a set-top box that can transmit and receive video and data. Ans. 23-24 and Ellis 5:15-21. The Examiner further found that this set-top box is the same as the media exchange network described by the Specification to perform the pushing of portions of content. Ans. 23-24. However, we find no evidence that the set-top box of Ellis performs the set required by claims 34, 37, and

40. Specifically, we find no evidence that the set-top box performs the step of "pushing at least a portion of said populated channel to said second location in exchange for at least a portion of a second populated channel guide associated with a second media channel created at said second location." As such, we do not sustain this rejection.

NEW GROUND OF REJECTION

The following new ground of rejection is entered pursuant to 37 C.F.R. § 41.50(b). Claims 2-10, 12-20, 22, and 26-29 are rejected under 35 U.S.C. § 103(a) as unpatentable over Wood, Novak, and Ellis.

As discussed *supra*, claims 2, 12, and 22 recite "the mixed media content comprises at least one personal media content and at least one broadcast media content." Ellis teaches a Main Menu 156 that includes TV Listings 158, Internet 160, and Personal Channels 162. Ellis Fig. 11. Ellis specifically teaches that a viewer is provided with access to program schedule information that includes traditional television channel schedule and personal television schedule information. Ellis 12:60-64. Personal television channel programming is created by users on topics suitable for personal television, including sports, theater, local events, school events, public meetings, music, education, shopping, a particular interest, or off-beat topic. Ellis 3:21-29. That is, personal television programming is personal media content, TV listings are broadcast media content, and the main menu is a channel guide. As discussed by the Examiner, claim 1 requires that the channel guide, and not the channel, is populated with the mixed content. Ans. 16. As such, Ellis teaches populating the channel guide with

information identifying mixed media content, where the media content includes personal media content and broadcast media content. Claims 3-10, 13-20, and 26-29 depend from claims 2, 12, and 22 and are rejected for the same reasons.

CONCLUSIONS OF LAW

The Examiner did not err in rejecting 34, 37, and 40 under 35 U.S.C §112, first paragraph, as failing to comply with the written description requirement.

The Examiner did not err in rejecting claims 1, 11, 21, 23-25, 31-33, 35, 36, 38, and 39 under 35 U.S.C §103(a) as being unpatentable over Wood and Novak.

The Examiner erred in rejecting claims 2-10, 12-20, 22, and 26-29 under 35 U.S.C §103(a) as being unpatentable over Wood and Novak.

The Examiner erred in rejecting claims 34, 37, and 40 under 35 U.S.C §103(a) as being unpatentable over Wood, Novak, and Ellis.

A new ground of rejection is entered 37 C.F.R. § 41.50(b) and claims 2-10, 12-20, 22, and 26-29 are rejected under 35 U.S.C. § 103(a) as unpatentable over Wood, Novak, and Ellis.

DECISION

To summarize, our decision is as follows.

- The rejection of claims 34, 37, and 40 under 35 U.S.C §112, first paragraph, as failing to comply with the written description requirement is sustained.
- The rejection of claims 1, 11, 21, 23-25, 31-33, 35, 36, 38, and 39 under 35 U.S.C §103(a) as being unpatentable over Wood and Novak is sustained.
- The rejection of claims 2-10, 12-20, 22, and 26-29 under 35 U.S.C §103(a) as being unpatentable over Wood and Novak is not sustained.
- The rejection of claims 34, 37, and 40 under 35 U.S.C §103(a) as being unpatentable over Wood, Novak, and Ellis is not sustained.
- A new ground of rejection is entered pursuant to 37 C.F.R. § 41.50(b).
    - Claims 2-10, 12-20, 22, and 26-29 are rejected under 35 U.S.C. § 103(a) as unpatentable over Wood, Novak, and Ellis.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2010).

AFFIRMED-IN-PART
41.50(b)

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